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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,586	10/09/2003	Edward R. diGirolamo	4782-030	9767

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RALEIGH, NC 27602

EXAMINER

A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
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3637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/682,586

Applicant(s)

DIGIROLAMO ET AL.

Examiner

Phi D. A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 9,10,12-20 and 25-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,11,21-24,34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

CLAIMS 9, 10, 25-33 ALSO NEED TO BE LABELED AS "WITHDRAWN". The claims are treated as withdrawn claims.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“ is connected” is indefinite as it confuses the scope of the claim. The claim is to a stud spacer only, not a system with stud spacers connected to each other. Should it be “ is adapted to be connected”?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 11, 21-24, 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Vukmanic (4677802).

Vukmanic shows a stud spacer (12) for extending between two studs with each stud having an opening therein, the spacer comprising a main member (17), the main member including first and second end portions(40), a projection (41) extending from one of the end

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portions, an opening (50) formed in the other end portion and wherein one stud spacer may be connected to another stud spacer by extending the projection of the one stud spacer through the opening within one stud and into the opening of another stud spacer, at least one flange (71) for connecting to one of the two studs, spaced apart flanges (71, and at 40) for connecting to one of the two studs, the opening formed in the second end portion of the main member including a slot, a projection receiver (50) formed in the other end portion, either the projection or projection receiver including one or more locking members such that when a projection of one of the spacer is projected into the receiver of another spacer, a locked condition is realized, either the projection or projection receiver includes one or more stops for engaging the one or more locking members (figure 4), the locking members are disposed on the projection and the stops form a part of the receiver, at least a portion of the projection is deflectable in response to the projection engaging the receiver, the projection and receiver are disposed such that when consecutive stud spacers are connected together, the projections and receivers will overlies each other (figure 4), the projection and receiver include a flap that is at least partially flexible, in a locked position, the flaps of the projection and receiver engage each other (figure 4), both the projection and receiver include a flexible flap, a hold down element, an opening disposed between the flap and the hold down element, a deflector, an opening disposed between the deflector and the hold down element.

5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kovar et al (4246736).

Kovar et al shows a stud spacer (10), the spacer comprising a main member, the main member including first and second end portions (13, 14), a projection (19, 71) extending from

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one of the end portions, an opening (between 15 and 16) formed in the other end portion and wherein one stud spacer may be connected to another stud spacer by extending the projection of the one stud spacer through the opening within one stud and into the opening of another stud spacer, at least one flange (the part to the left of part 74, 73, figure 8) for connecting to one of the two studs, spaced apart flanges (the parts to the left of part 74, 73, figure 8) for connecting to one of the two studs, the main member including a pair of side flanges (12, 25, figure 1) and a pair of end flanges (the part to the left of part 74, 73, figure 8), the end flanges are adapted to be connected to the two studs that the stud spacer extends between, the main member includes a central section (figure 2A, the portion in the middle), and wherein the side flanges (25) are turned out of the plane of the central section, the end flanges and the side flanges are turned in opposite directions with respect to the central section (the orientation of the side flanges in figure 1 and the orientation of the end flanges in figure 8), at least one end flange is divided into at least two portions (figure 8) and the projection (71) extends between the two portions.

Response to Arguments

1. Applicant's arguments filed 10/20/06 have been fully considered but they are not persuasive.
2. With respect to Vukmanic, applicant states that the 102 rejection is improper as the claimed limitations "stud and stud spacer" have been misconstrued and unreasonable. Examiner respectfully disagrees. As set forth, the claims are to a stud spacer and its specific structures, not a wall or a stud. The reference Vukmanic shows the stud spacer with its specific structures as claimed, and able to function as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Also, examiner reasonably interpretes broadly applicant's claimed language. The argument is thus moot.

With respect to applicant's argument to Kovar et al not showing all the claimed limitations, examiner respectfully disagrees. As set forth, the claims 1-8, are to a stud spacer, not a system or a plurality of stud spacers. The limitation of "wherein one stud spacer is connected to another stud spacer by extending the projection of the one stud spacer through the opening within one stud into the opening of another stud spacer" has 112 issue as set forth above and is properly interpreted as best understood to mean "wherein one stud spacer is adapted to be connected to another stud spacer by extending the projection of the one stud spacer through the opening within one stud into the opening of another stud spacer". This interpretation is consistent with applicant's preamble of "A stud spacer for....therein". Thus, only a stud spacer is claimed. The reference shows the stud spacer with its specific structures as claimed. The reference is also able to function as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The argument is thus moot.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A

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